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09/639,948	08/17/2000	Ned Hoffman	STA-25	4850
20575	7590	07/14/2004	EXAMINER	
MARGER JOHNSON & MCCOLLOM PC 1030 SW MORRISON STREET PORTLAND, OR 97205			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER

3621

DATE MAILED: 07/14/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/639,948  
Filing Date: August 17, 2000  
Appellant(s): HOFFMAN, NED

ARIEL S. ROGSON  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 19<sup>th</sup>, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-63 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

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Rechtin, Mark, Fingerprint Technology Makes for Best ID system, May 1990, Orange County Business Journal, Newport Beach, Vol. 12, iss. 51, Sec. 1, page 7

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drexler et al (U.S. Patent no. 5,457,747) in view of Mark Rechtin (*Fingerprint Technology Makes for Best ID System, Published by Orange County Business Journal, May 14<sup>th</sup>, 1990*).

3. As per claim 1, Drexler et al teach a method for tokenless biometric authorization of an electronic communication, using a biometric sample, a master electronic identifier, and a public communications network, wherein the method comprises an electronic communication formation, wherein at least one communication comprising electronic data is formed a user registration step, wherein a user electronically submits a registration biometric sample taken directly from the person of the user, a public network data transmittal, wherein the registration biometric sample is electronically transmitted to a master electronic identifier via a public

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communications network, the master electronic identicator comprising a computer database which electronically stores all of the registration biometric samples from all of the registered users, a user registration biometric storage, wherein the registration biometric sample is electronically stored within the master electronic identicator, a bid biometric transmittal, wherein a bid biometric sample, taken directly from the person of the user, is electronically transmitted to at least one electronic identicator, a user identification, wherein an electronic identicator compares the bid biometric sample to at least one registration biometric sample previously stored in an electronic identicator, for producing either a successful or failed identification of the user, an electronic communication authorization wherein upon a successful identification of the user by an electronic identicator, at least one electronic communication is authorized for execution (*see abstract, figs 1 and 3, column 2 lines 20-3 line 36, 4 lines 61-5 line 4*). Drexler et al fail to teach an inventive concept of an electronic communication is biometrically-authorized without the user having to present smartcards, or magnetic stripe cards. However, Rehtin teaches an inventive concept of an electronic communication is biometrically-authorized without the user having to present smartcards, or magnetic stripe cards (*see abstract*). However, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the inventive to include Rehtin's inventive concept of an electronic communication is biometrically-authorized without the user having to present smartcards, or magnetic stripe cards because this would have facilitate customer interaction with the secure transaction system.

4. As per claim 32, Drexler et al teach a system for tokenless biometric authorization of an electronic communication, using an electronic communication input apparatus, a biometric input

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apparatus, and a master electronic identifier, wherein the system comprises a communication input apparatus, further comprising a data entry device for formation of an electronic communication, a biometric input apparatus, further comprising a device for electronically scanning a biometric sample directly from the person of a user, at least one master electronic identifier, further comprising a computer database containing all of the electronically stored biometric samples from all of the registered users, a comparator that electronically compares received a biometric sample with previously stored biometric samples to deliver either a successful or failed identification of the user, a data transmittal public network that electronically transmits data between the biometric input apparatus and a master electronic identifier, an electronic communication authorization platform that authorizes execution of at least one electronic communication upon a successful identification of the user by an electronic identifier (*see abstract, figs 1 and 3, column 2 lines 20-3 line 36, 4 lines 61-5 line 4*) . Drexel et al fail to teach an inventive concept of an electronic communication is biometrically-authorized without the user having to present smartcards, or magnetic stripe cards. However, Rehtin teaches an inventive concept of an electronic communication is biometrically-authorized without the user having to present smartcards, or magnetic stripe cards (*see abstract*). However, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the inventive to include Rehtin's inventive concept of an electronic communication is biometrically-authorized without the user having to present smartcards, or magnetic stripe cards because this would have facilitate customer interaction with the secure transaction system.

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5. As per claims 2-31 and 33-67, they are dependent upon claims 1 and 32 and disclose the same inventive concept as claims 1 and 32. Therefore, they are rejected under the same rationale

**(11) Response to Argument**

A. In section A of Appellant's argument, Appellant remarks concentrate on the history of the prosecution. Appellant argues that Examiner's broad-brush office action disregard patentable distinction between the claimed invention and the prior arts. Appellant further argues that Examiner has considered arguments presented in the response to previous office action moot in view of the new ground of rejection, which subsequently was made final. Examiner respectfully disagrees with Appellant argument. First and foremost, the office action did not disregard the distinction between the claimed invention and the prior art. In applying the best possible art (Drexler and Rehtin), examiner did not see any distinction between the claimed invention and the prior arts. In fact the logical combination of the prior arts clearly read on the claimed invention and Appellant amendment fail to distinguished the claimed invention and the prior arts. Second, The action was made final in light of the amendment claim. In view of the amendment, Examiner was forced to conduct additional search in considering the added limitation. Therefore, Appellant's amendment necessitated the new ground(s) of rejection presented and the action was final according to MPEP § 706.07(a).

B. In section B, Appellant argues that the claimed subject matter has substantial difference over the prior art. Although Appellant discussed the claimed invention and the prior

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arts, Appellant fail to point out the the substantial difference between the claimed invention and the prior arts.

C. In section D part 1, Appellant argues Examiner's acknowledgment that Drexler fails to teach authorizing an electronic communication without using a smart card or a magnetic card. Appellant point out the Examiner relies on the teaching of a published article by Rechtin which discuss an inventive concept wherein no credit cards to carry no secret code numbers to memorize. In Rechtin disclosure a user would just walk up to the cash machine and stub the thumb against a viso-screen and see the transaction authorized within five seconds. When a user walk back to the car, there are no keys to hassle with. Your thumbprint opens the door. Rechtin indicate that Officials of biometric industry firms, who currently see most of their contracts for fingerprint identification systems with law enforcement that the next extension of the technology is in personal security. Appellant argues that is it not possible to modify Drexler's inventive concept to include Rechtin and no motivation is provided for such combination. Examiner respectfully disagrees with Appellant characterization of the prior art and the combination. Drexler teaches a card system with a verification terminal having means for acquiring biometric identification and common identification information from a person, for indelibly writing the first medium with the biometric identification information, for subsequently reading the biometric identification information of the first medium, for comparing the biometric identification information read from the first medium with that of a possessor of the card, and for writing data on the second data storage medium in response to a favorable comparison, the data authorizing limited use of the card. Drexler teach all the steps in the claimed invention except the step of a transaction without using a card. It is very much possible to modify the inventive



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concept of Drexler to include Rehtin concept wherein no card is needed in order to conduct secured transaction. Since all the biometric information have already been record in Drexler system, any transaction in the combined concept can occur without the use of the card. Thereby making the card useless. Moreover, Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references are combinable since they disclose inventive concept that are in the same secured transaction environment.

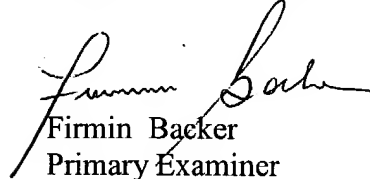
E. In summary the reminder of the discussion (part 2-8) is based on the same arguments as part 1. Therefore the same response applied to the rest of the arguments.

For the above reasons, it is believed that the rejections should be sustained.

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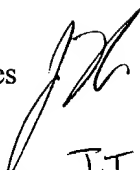
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Respectfully submitted,

  
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Art Unit 3621

July 12, 2004

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